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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/195,105	11/18/98	FRANCISCO	2434.114

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EXAMINER	
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ART UNIT	PAPER NUMBER

2765

11

DATE MAILED: 04/20/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/195,105

Applicant(s)  
Francisco, et al.

Examiner  
Akiba Robinson-Boyce

Group Art Unit  
2765



☒ Responsive to communication(s) filed on Nov 18, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-13 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) ~~1-5, 7-10, and 13~~ 1-13 is/are rejected.

☒ Claim(s) ~~6, 11, and 12~~ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5, 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2765

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 5,875,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because the content of the applicant's claim are the same except for the addition of certain segments.

Art Unit: 2765

As per claim 1, the following segments are not identical, but are obvious over claim 1 of U.S. Patent No. 5,875,433:

A point of sale tax reporting system in an environment...(A point of sale tax reporting system in...a digital data network):

at least one tax register located at a merchant or retailer location...(at least one tax register located at a retailer location)

a first computer and corresponding first memory disposed at the state agency...receiving and storing the forwarded use tax data from one of the credit card processing company and a merchant...(a first computer and corresponding first memory disposed at the state agency...receiving and storing the forwarded use tax data...)

a first communication link connecting at least one of (I) the tax register...(a first communication link connecting the tax register...)

As per claim 2, the following is not identical, but are obvious over claim 3 of U.S. Patent No. 5,875,433:

wherein the consumer purchases foods with one of a credit card...(wherein the system includes means at the retailer location for accessing a credit card...)

Art Unit: 2765

As per claim 3, the following is identical in the conflicting claim 2:

wherein the first communication link is one of a digital...

As per claim 4, the following is identical in the conflicting claim 3:

wherein the system includes means at the retailer location for accessing a credit card company...

As per claim 5, the following is not identical, but is obvious over claim 4 of U.S. Patent No. 5,875,433:

further including means for allowing the credit card company to forward...

As per claim 7, the following is identical in the conflicting claim 1:

a digital data network provided so as to connect the retailer...

As per claim 8, the following is not identical, but is obvious over claim 2 of U.S. Patent No. 5,875,433:

wherein said link includes one of a telephone line, a digital data network...(wherein the first communication link is on of a digital packet switched network...)

As per claim 9, the following segments are identical in the conflicting claims:

A point of sale tax reporting system...

Art Unit: 2765

The following segments are not identical, but are obvious over claim 1 of U.S.

Patent No. 5,875,433:

the digital data network for enabling a consumer...(a digital data network provided so as to connect...)

a least a first computer or register...(a least one tax register...)

at least a second computer and corresponding memory disposed at the state authorized entity...(a first computer and corresponding first memory disposed at the state agency...)

a first communication link connecting at least one of...(a first communication link connecting the tax register...)

As per claim 10, the following is not identical, but is obvious over claim 1 of U.S. Patent No. 5,875,433:

wherein the first computer or register computes the tax data...(at least one tax register...computing use tax data)

As per claim 13, the following is not identical, but is obvious over claim 4 of U.S. Patent No. 5,875,433:

Art Unit: 2765

further comprising means for charging a credit card...(wherein the system includes means at the retailer location for accessing a credit card...)

3. The following is a statement of 37 CFR 3.73, which became effective on September 4, 1992, and was revised to its present form in 1997:

***Terminal Disclaimer***

**37 CFR 3.73 Establishing right of assignee to prosecute.**

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application unless there is an assignment.

(b) When an assignee seeks to take action in a matter before the Office with respect to a patent application, trademark application, patent, registration, or reexamination proceeding, the assignee must establish its ownership of the property to the satisfaction of the Commissioner. Ownership is established by submitting to the Office, in the Office file related to the matter in which action is sought to be taken, documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment submitted for recording) or by specifying (e.g., reel and

Art Unit: 2765

frame number) where such evidence is recorded in the Office. The submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. Documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office.

***Allowable Subject Matter***

4. Claims 6, 11 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

5. An inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba Robinson-Boyce whose telephone number is (703) 305-1340. The examiner can normally be reached on Monday-Friday from 6:30AM-3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached on (703) 305-9708.



Art Unit: 2765

The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3988.

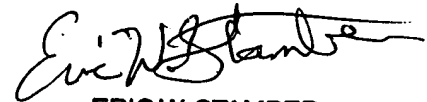
An inquiry of a general nature or relating to the status of this application proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

**Akiba Robinson-Boyce**

**Patent Examiner**

**Group Art Unit 2765**

**March 28, 2000**

  
ERIC W. STAMBER  
PRIMARY EXAMINER